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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/318,447	05/25/1999	PERI HARTMAN	249768002US2	1430

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EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/318,447

Applicant(s)

HARTMAN ET AL.

Examiner

Mark A Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 108-183 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 108-183 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11,111
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: 37 CFR § 1.105.

DETAILED ACTION

Response to Amendment

The Examiner is in receipt of Applicant's response to Office Action mailed 8/19/2002, which was received by the Office 12/24/2002. Acknowledgement is made to the cancellation of claims 49-107, the addition of new claims 108-165 and 167-183, the submittal of IDS's received 12/24/2002 and 7/12/2002 paper numbers 15 and 11 respectively. The 35 U.S.C. 112 rejection concerning the use of a shopping cart was successfully traversed and the rejection has been removed. The 35 U.S.C. 112 rejection concerning "Express ordering" is also overcome by the removal of the term from the new claims. The arguments and IDS's have been carefully reviewed, however, a new rejection based on the newly submitted IDS and amended claims dated 12/24/2002 is submitted below. Also note that the substitute specification received 1/6/2003 will neither be considered nor entered. The amendment was insufficient to overcome the Double Patent rejection, which is applied once again below.

37 CFR § 1.105

A complete response to this Office action must include a complete response to the 37 CFR § 1.105 attached. The time of response to the Office action coincides with the time period for reply to the attached 37 CFR § 1.105, which is 3 months.

Reference Cited

The reference "Virtual Store", which has a Copy write date of 1997, was first published November 8, 1996. Per telephone conversation (2/26/2003) with Ms. Georgiana Manning, Customer Service Representative at the Indianapolis office of John

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Wiley and Sons; her records did not show any editions being made from the original publish edition of November 8, 1996. Based on this information the reference "Virtual Store" by Magdalena Yesil has an effective date of November 8, 1996. See also product details for Creating The Virtual Store at <http://www.amazon.com/exec/obidos/tg/detail/-/04711641/002-1591836-2687212?vi=glance>, dated 2/26/2003.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 108-183 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the specification and claims of U.S. Patent No. 5,960,411. Although the conflicting claims are not identical, they are not patentably distinct from each other because both describe a method of making a

purchase using a single action as opposed to using a shopping cart method, which normally requires an additional step of checkout.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 114,115,116,134,135,136,144,145,146,173,174,181 and 182 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the case of these claims the term "partial" renders the claim indefinite since the whole is not distinctly defined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 108-165, and 167-183 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn 373 (6,058,373) in view of Blinn 622 (5,897,622), in view of Yesil (a book reference see PTO 892), in view of Wojcik et al (5,666,493), and further in view of Official Notice.

In regards to claims 108,126,127,130,131,,140,151,158,168,and 176, Blinn 373 discloses a method and system for:

receiving from a server system a client identifier of the client system; persistently storing the client identifier at the client system (col 9 line 60 to col 10 line 61); when an item is to be ordered,

; and

the client identifier identifying account information previously supplied by a user of the client system wherein the user does not need to log in to the server system when ordering the item (col 31, line 35 to col 38, line 38); and

when account information is to be changed, coordinating the log in of the user to the server system; receiving updated account information; and

sending the updated account information to the server system whereby the user does not need to log in to the server system when ordering the item, but needs to log in to the server system when changing previously supplied account information. Blinn 373

teaches maintaining customer information at a server (see discussion above) but does not specifically mention a vehicle for updating information on the server. Blinn 622 teaches a registration form for a new user and update page to update stored information (col 7 lines 53-67). It would have been obvious to a person of ordinary skill in the art to include in Blinn 373, the update method as taught by Blinn 622, because this would provide a vehicle to enter information that has change such as method of payment or shipping address, which are essential to assuring an order is processed correctly.

displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item. Blinn 373 teaches a "purchase now button" that when activated places the order (FIG 6), but does not specifically teach that the order is placed in a single action. Yesil teaches an "instant buy button" which enables the buyer to skip the check out review. It would have been obvious to a person of ordinary skill in the art to include in Blinn 373 the "instant buy button" as taught by Yesil, because this provides added appeal for customers who already know the single item they want to purchase.

automatically generating a single order for the identified items of the one or more received requests for items wherein the user does not need to specify that the identified items are to be combined into a single order Blinn teaches a database that stores information on an order such as order date and shipping address and a customer identifier, which can be manipulated to provide information concerning an order, but

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does not specifically mention consolidating orders before a specified time has expired.

Wojcik teaches optimizing shipment of multiple orders by consolidation, where the

decision can be based on delivery date of the order (col 8, line 52 to col 10 line 36). It

would be obvious to a person of ordinary skill in the art to include in Blinn 373 the order

consolidation techniques as taught by Wojcik, because shipping is expensive,

particularly for small items, consolidation of numerous small orders into one shipment

would save the consumer shipping costs. Concerning the different time intervals,

Wojcik's decision to ship different orders together is based on delivery date, which is a

finite time, therefore, only the lag time between the ship date required to deliver the

product on time and the actual placement of order can be used to determine if an order

can be combined. To limit the time within this finite period would require only ordinary

skill in the art. Since Wojcik does not limit the interval before an order cannot be

combined it can be assumed that any interval between the actual order and the required

ship date (short, intermediate or long term including 90 minutes could be used. It would

be obvious to a person of ordinary skill in the art to include in Wojcik, a specified

combination time interval, because this would limit the requirement for notifying the user

of combined shipments.

In regards to claims 109,110,152,153,177,178, Blinn 373 teaches wherein the account information includes billing or shipping information (FIG's 4-6, "Gary's Card and "Gary's House").

In regards to claims 111,132,142,170,179, Blinn 373 teaches wherein the client system and server system communicate via the Internet (FIG 1).

In regards to claim 112, Blinn 373 teaches receiving from the server system a confirmation that the order was generated. The use of a confirmation message to inform a customer that the purchase has been completed is old and well known in the art and could have been incorporated into Blinn 373, because the customer would require this information to assure that the transaction has indeed been completed.

In regards to claim 113, Blinn 373 teaches wherein the single action is clicking a mouse button when a cursor is positioned over a predefined area of the displayed information (Yesil, "instant buy button").

In regards to claims 114,115,116,134,135,136,144,145,146,173,174,181,182, Blinn 373 teaches a server providing partial information (FIG's 4-6, "Gary's Card and "Gary's House").

In regards to claims 117,137,147,155,165,175,183, Blinn 373 teaches wherein the item may alternatively be ordered using a shopping cart model (Yesil, page 326, Instant Buy Option).

In regards to claims 118,148,156, Blinn 373 teaches wherein the server system combines multiple requests to order items into a single order (see response to claim 108 above).

In regards to claims 133,143,154,164,167,171,180, Blinn 373 teaches wherein the single action is clicking a mouse button when a cursor is positioned over a predefined area of the displayed information (see response to claim 113).

In regards to claim 172, Blinn 373 teaches wherein the display page includes information identifying the user (FIG's 4-6, "Gary's Card and "Gary's House").

In regards to claims 119, 120, 121,122,123,125,128,129,139,141, 149,150,159, 160, 161,162,163, 169 Blinn 373 teaches wherein requests are combined when sent within a certain time interval.

In regards to claims 124,138,157, Blinn 373 teaches displaying an indication that the order for the item that is requested in response to performing the single action can be canceled within a time period. Blinn 373 teaches the claimed feature except for giving the opportunity to change the order after it has been submitted. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to move the functionality of the shopping cart from prior to purchase to after the orders have been place through a single click, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86

USPQ 70. Further, this would be necessary to allow the customer an opportunity to cancel an order if an order was made incidentally.

Response to Arguments

Applicant's arguments with respect to claim 108-183 have been considered but are moot in view of the new ground(s) of rejection necessitated by the Information Disclosure Statement and amended claims received 12/24/2002.

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) and the amended claims submitted on 12/24/2002 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Friday 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington D.C. 20231


or faxed to:

(703) 305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


Mark Fadok
Patent Examiner


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

37 CFR § 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the Examiner has determined is reasonably necessary to the examination of this application.

This information is required to complete the record so that an analysis of potential public disclosure and to identify products and services embodying the disclosed subject matter and identify the properties of similar products and services found in the prior art. Thus, the following information is requested:

This requirement is based on An article in Intellectual Property & Technology Law Journal Titled "Preliminary Injunction lifted in "One Click" Patent Battle" Vol 13, Number 5, May 2001

In the article mention is made of a prior art Web Page that has the sentence "A single click on its picture is all it takes to order and item." This web Page is request along with any other prior art of record related to litigation concerning Patent # 5,960,411.

Additionally all summary court judgments and opinions are also requested. Please note that the instant application claims priority to patent # 5,960,411 as a continuation and the Examiner has previously rejected the claims of the instant application as Double Patenting to the invention claimed in Patent # 5,960,411.

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The fee and certification requirements of 37 CFR § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR § 1.105 are subject to the fee and certification requirements of 37 CFR § 1.97.

The Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR § 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment to the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time response to the enclosed Office action coincides with the time period for reply to the enclosed Office action, which is 3 months.

The period for reply to an Office action on the merits is ordinarily set for 3 months.